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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,834	03/05/2002	Keitaro Aoshima	003510-123	4828

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EXAMINER

HAMILTON, CYNTHIA

ART UNIT PAPER NUMBER

1752

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/087,834

Applicant(s)

AOSHIMA, KEITARO

Examiner

Cynthia Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-10,13,17-40 and 42-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 35-40 and 42-48 is/are allowed.
- 6) ☒ Claim(s) 1-3,5-10,13 and 17-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-3, 5-10, 13, and 17-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The addition of the word "type" to an otherwise definite expression extends the scope of the expression so as to render it indefinite. See particularly *In re Copenhagen*, 109 USPQ 118 (Bd. App. 1955) and *Ex parte Attig*, 7 USPQ2d 1092 (Bd. Pat. App. & Inter. 1986) and MPEP 2173.05 (b). Applicants have added to the preamble of claims 1-3, 5-10, 13, and 17-34 "negative-type" in reference to the planographic printing plate precursor claimed. The examiner found no clear definition as to what was meant by "type" with respect to "negative" nor is she clear to what "negative" references. Is "negative" in reference to the inked image formed from the plate? Is "negative" in reference to the nature of the crosslinkable or polymerizable nature of the photosensitive layer? It is not clear with respect to "negative" alone and especially not clear when "type" is added without specific definition in the original disclosure. Thus, claims 1-3, 5-10, 13, and 17-34 are held confusing.

3. Claims 35-40 and 42-48 are allowed.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1-3, 5-10, 13 and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hauck (US 6,555,291 or W0 02/14071 A1) in view of Rousseau (4,228,232) further in view of Smith (3,729,313) and Crivello (4,058,401 or 4,058,400). Hauck discloses the instant planographic printing plate precursor with the use of phenolic or sulfonamide polymers in his top coat layer. The top layer is not described in reference to a contact angle but instead is required to be developable in aqueous base developer with the imaged material being removed and the non-imaged material remaining. It is the top layer that is ink receptive, i.e. hydrophobic. In col. 13, under Image Formation, the image formed is positive leaving the top layer as it was in its unexposed state, after development the plate is overall cured if a negative-working base soluble photosensitive composition is the underlayer. Hauck discloses the use of photopolymerizable and photocrosslinkable negative working base soluble photosensitive composition under layers with photothermal conversion materials that are preferably not in the top layer. Hauck does not disclose the use of onium or sulfonium salts as photoinitiators in the photopolymerizable and photocrosslinkable negative working base soluble photosensitive composition under layers. However in col. 8, lines 46-54, Hauck does disclose using free radical initiating agents that are activatable in ultraviolet and/or visible regions of the spectrum from 300 to 800 nm. While onium salts are not given as preferred examples, the use of such is well known in the art as set forth by Rousseau in col. 10, lines 17-50, with equivalence for this purpose being also shown for many of the compounds cited by Hauck as useful. Rousseau lists diazonium, iodonium and sulfonium free radical initiators and cites Smith and Crivello as showing this use of said free radical initiators as known in the art. Thus, with respect to instant claims 1-3, 5-10, 13, and 17-21, the thermal digital lithographic printing plates of Hauck wherein the negative-working base

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soluble photosensitive composition is the underlayer are obvious in view of their use in the examples and the use of photopolymerizable elements in the a negative-working base soluble photosensitive composition is obvious because they are taught to be so used and the use of well known equivalent free radical photoinitiators inclusive of sulfonium, iodonium and diazonium salts as set forth by Rousseau further supported by Smith and Crivello would have been prima facie obvious as well. In Hauck, see particularly claims, examples, abstract, and particularly "Negative-Working Base Soluble Photosensitive Compositions". See in Hauck, col. 10, "Top Layer". In col. 14, lines 25-42, the top layer is removable by the developer of Hauck but less so than the regions exposed to irradiation. Thus, the top layer of Hauck acts as required by instant claims 1-3, 5-10, 13, 17-21. Applicants added "negative type" to the preamble of instant claims 1-3, 5-10, 13, and 17-21 but without clear definition of the meaning of negative or the addition of type to negative in view of the presence of a polymerizable or crosslinkable layer, the examiner cannot determine if the precursors of Hauck are negative-type because of the layer that hardens or if the nature of the top layer of Hauck is such that a negative inking image could never be obtained from the plate of Hauck even if processing were different than that of applicants. Thus, the rejection remains due to the confusion as to the meaning of "negative-type" in the preamble as added by applicant's amendment in view of the original disclosure.

6. Applicant's arguments filed October 29, 2004 have been fully considered but they are not persuasive. The examiner agrees with applicants' description of the difference between applicants process and the process of Hauck. However, she does not believe that this difference extends to a difference in the precursor plates of the claimed invention and the precursor plates of Hauck. Where the plates of Hauck imaged with UV light first then developed would they not

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be “negative” plate precursors and produce a negative image? As to the use of “type”, there is no clear definition for “negative-type” given in the original disclosure. The examiner took great pains to look for a clear definition of “negative-type planographic printing plate precursor” and did not find one. Applicants in their arguments on page 21 even label the photosensitive layer of Hauck as “Negative-photosensitive layer”. Thus, the confusion over “negative-type” leaves unclear the instant limits in claims 1-3, 5-10, 13, and 17-21 and the examiner cannot determine if the plates of Hauck are actually different than applicant’s plates with respect to these claims. Are the top layers of Hauck still totally removable upon extended development leaving a hydrophobic layer present in Hauck? Because the addition of “negative” does not clearly distinguish the instant plates over those of Hauck as well as the confusion over “type”, the rejection stands.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Hamilton whose telephone number is 571-272-1331.

The examiner can normally be reached on Monday through Friday 9:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571) 272-0729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



April 16, 2005

Cynthia Hamilton
Primary Examiner
Art Unit 1752

**CYNTHIA HAMILTON
PRIMARY EXAMINER**